

REMARKS

Claims 6-10 are pending in this application. By this Amendment, claims 6 and 9 are amended. Support for the amendments to the claims may be found, for example, in the specification at paragraphs [0032], [0033], [0045] and [0046]. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments amplify issues previously discussed throughout prosecution); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

I. Interview

The courtesies extended to Applicants' representative by Examiner Gugliotta at the interview held January 30, 2009, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

II. Rejection Under 35 U.S.C. §103(a)

The Office Action rejects claims 6-10 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2003/0021949 to Tomita et al. (hereinafter "Tomita") in view of WO 93/10886 (hereinafter "Farrauto") in further view of U.S. Patent No. 5,998,328 to Dawes et al. (hereinafter "Dawes"). Applicants respectfully traverse the rejection.

By this Amendment, claims 6 and 9 are amended to more clearly distinguish over the applied references. Specifically, claims 6 and 9 are amended to recite "...firing the resulting honeycomb structure to obtain a porous honeycomb structure with an oxide film on the surface of the porous honeycomb structure, and loading, on the surface of the porous honeycomb structure via the oxide film, a catalyst containing alumina and ceria as main components...." The applied references fail to teach or suggest or establish any reason or rationale to provide such a combination of features, as recited in claims 6 and 9.

Page 3 of the Office Action acknowledges that Tomita and Farrauto are silent in regard to creating an oxidizing atmosphere using steam. Dawes fails to cure the deficiencies of Tomita and Farrauto.

Dawes relates to an activated carbon catalyst that is coated onto a support. Dawes uses steam to activate the carbon, which supposedly enhances the volume and diameter of the micropores formed during carbonization. There is no indication in Dawes that the presence of steam will promote oxide film formation as required by the methods of claims 6 and 9, without a continuous layer of carbon present.

Furthermore, Dawes discloses that in the method of combining catalyst and carbon precursors, the amounts of catalyst precursors are limited because care must be taken that the carbon and catalyst precursors are compatible. See Dawes, col. 1, lines 62-67 (reproduced below for convenience).

Despite the advantages provided by this latter method of combining catalyst and carbon precursors, the types and amounts of catalyst precursors are limited because care must be taken that the carbon and catalyst precursors are compatible and that the carbon precursor solution is not overly diluted with the catalyst precursor.

Column 8, lines 1-17 of Dawes lists a number of catalysts, but fails to list a "catalyst containing alumina and ceria as main components," as recited in claims 6 and 9.

Accordingly, one of ordinary skill in the art would have had no reasonable expectation of successfully combining the teachings of Dawes with Tomita and Farrauto to achieve the method of claims 6 and 9.

At most, it appears that the Office Action may be taking Official Notice that catalysts containing alumina and ceria as main components will behave identically to those of Dawes. However, the application of Official Notice is not established and, thus, is improper in this case. With respect to Official Notice, the MPEP states that “such rejections should be judiciously applied” (see MPEP § 2144.03). “Official notice without documentary evidence to support an [E]xaminer’s conclusion is permissible only in some circumstances” (see MPEP § 2144.03(A)). “It would not be appropriate for the [E]xaminer to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known” (see *Id.*, emphasis added). Thus, for at least the above reasons, the Office Action's rejection of claims 6 and 9 over the combination of Dawes with Tomita and Farrauto is improper because there is no reasonable expectation of success that the alleged combination will lead to the method of claims 6 and 9.

Clearly, the combination of Tomita, Farrauto and Dawes is based upon impermissible hindsight because the Office Action combines the applied references solely based on Applicants' claims as a roadmap, which is clearly improper. It is Applicants' disclosure that provides and claims a method for preparing a silicon carbide-based catalyst body, characterized by extruding a raw material containing silicon carbide particles to obtain a honeycomb structure, firing the honeycomb structure, then subjecting the fired honeycomb structure to a heat treatment in an oxygen-containing atmosphere to obtain a porous honeycomb structure with an oxide film on the surface of the porous honeycomb structure, and loading, on the surface of the porous honeycomb structure via the oxide film, a catalyst containing alumina and ceria as main components. Therefore, the combination of Tomita,

Farrauto and Dawes is improper and, as a result, claims 6 and 9 would not have been rendered obvious by Tomita, Farrauto and Dawes, alone or in combination.

Additionally, as argued above, the Office Action has provided no factual support for its allegations and, thus, the rejections are improper because the Office Action fails to provide a clear articulation of the rejection. MPEP § 2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit” (emphasis added). Applicants respectfully note that at least because the Office Action failed to establish a prima facie case of obviousness, any rejection in a subsequent Office Action providing adequate reasoning would be presented for the first time on the record and as such, a next Action cannot be made final. Accordingly, it is respectfully submitted that the finality of the outstanding Office Action is improper and respectfully requested that said finality be withdrawn.

Furthermore, the patentability of the claims is supported by the unexpected results that show the oxygen content of a sample can be increased by conducting the heat treatment (even at a lower temperature) in the presence of steam. The unexpected results are reflected in the specification at Table 1, Example 15 (a heat treatment with steam at 1100°C resulted in an oxygen content of 3%) compared to Examples 2, 7, 9, 10, and 12 (heat treatments without steam conducted at 1200°C resulted in oxygen contents ranging from 2.0 to 2.5%). As seen in Table 1, Examples 2, 7, 9, 10, and 12 only had 67 to 83% of the oxygen content of Example 15 even though they were conducted with a heat treatment temperature 100°C higher than that of Example 15. The applied references fail to teach or suggest such results.

For at least the foregoing reasons, Applicants respectfully submit that claims 6 and 9 would not have been rendered obvious by Tomita, Farrauto and Dawes, alone or in

combination. Therefore, claims 6 and 9 and their dependent claims are patentable.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Benjamin S. Prebyl
Registration No. 60,256

JAO:BSP

Date: February 4, 2009

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461
--